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PATENT  
Attorney Docket No. AR218-X

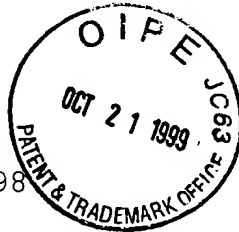
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Gregory HAMILTON, et al.

Filed: December 3, 1998

Serial No.: 09/204,236



Examiner: Celia Chang

Group Art Unit: 1612

For: **N-LINKED SULFONAMIDES OF HETEROCYCLIC CARBOXYLIC ACIDS  
OR CARBOXYLIC ACID ISOSTERES**

TRANSMITTAL LETTER

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Submitted herewith for filing in the U.S. Patent and  
Trademark Office is the following:

- 1) Transmittal letter; and
- 2) Response to Restriction Requirement.

If extensions of time under 37 CFR § 1.136 other than those  
provided herewith are required to allow consideration of papers  
accompanying this Petition, then such extensions of time are  
hereby petitioned. The Commissioner is specifically authorized  
to charge fee deficiency under 37 CFR §§ 1.16 or 1.17, or credit  
any overpayment, to Deposit Account No. 14-0112.

Respectfully submitted,  
**NATH & ASSOCIATES**

Date:

Oct 21, 1999

By:

Todd L. Juneau

Gary M. Nath  
Reg. No. 26,965  
Todd L. Juneau  
Reg. No. 40,669

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RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

**RECEIVED**

Assistant Commissioner for Patents  
Washington, D.C. 20231

**OCT 25 1999**

**TECH CENTER 1600/2900**

Sir:

This is a Response to the Official Action dated August 9, 1999, within two months of the issue date of the Official Action. No shortened period for response was set by the Examiner. Accordingly, this Response is filed within the six-month statutory time limit, set to expire February 9, 2000. If an extension of time under 37 CFR § 1.136 is required to allow consideration of this Response, then such an extension of time is hereby petitioned. The Commissioner is specifically authorized to charge any fee deficiency under 37 CFR §§ 1.16 or 1.17, or credit any overpayment, to Deposit Account No. 14-0112.

SUMMARY OF RESTRICTION REQUIREMENT

The Examiner has required restriction of claims 1 through 64 under 35 U.S.C. § 121 to a single disclosed invention encompassed by the claims as follows:

- I. Claim 5, drawn to pyrrolidinyl compounds (n=1), classified in class 548, subclass various depending on species election. If this group is elected, a further election of a single disclosed species is also required. Claims 1-4, 6-11 reading on the elected compounds can be prosecuted together with the compounds to the extent of the election. Claims 14-25, upon election of a single is closed pathology/disease treatable with the method, can be prosecuted with the elected compounds to the extend of the election.
- II Claims 12-13, and 26-27, drawn to composition and method of treating neurological disorder using the combination composition, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single combination of ingredients and a single pathology/disease treatable by the combination is also required.
- III Claims 28-34, drawn to method of stimulate peripheral nerve growth, classified in class various, subclass various. If this group is elected, a further election of a single disclosed compound for the method is also required.
- IV Claims 35-36, drawn to method of stimulate peripheral nerve growth by combination of active ingredients, classified in class various, subclass various. If this group is elected, a further of a single disclosed combination of active ingredients for the method is also required.
- V Claims 37-43, drawn to method of neuro-regeneration, classified in class various, subclass various. If this group is elected, a further election of a single disclosed compound for the method is also required.
- VI Claims 44-45, drawn to method of neuro-regeneration, classified in class various, subclass various. If this group is elected, a further election of a single disclosed combination for the method is also required.
- VII Claims 46-55, drawn to method of preventing neurodegeneration, classified in class various, subclass various. If this group is elected, a further election of a single disclosed compound for the method is also required.
- VIII Claims 56-57, drawn to method of preventing neurodegeneration, classified in class various, subclass various. If this group is elected, a furler election of a single disclosed combination

for the method is also required.

IX Claims 58-64, drawn to composition and method of treating alopecia, classified in class various, subclass various, depending on species election. If this group is elected, a further election of a single disclosed compound for the method is also required.

X Claims 1-4 , 6-11, 14-25, remaining compounds and methods, further restriction is required.

The inventions are distinct, each from the other because:

The compounds differ in elements, bonding arrangement and chemical properties to such an extent that a reference anticipating compounds of one group would not necessarily imply unpatentability of another in the same claim. The methods are distinct and independent in end condition being treatable as well as the active ingredients or combination of active ingredients being employed. The search for each independent invention is not co-extensive and separate examination must be performed.

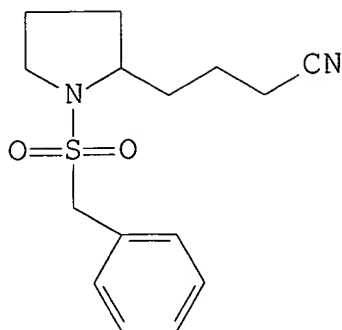
Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

As the basis for requiring this restriction/election, the Examiner has only provided that the species and methods falling under the above claims are patentably distinct from each other.

#### **ELECTION**

Applicants provisionally elect group I -- Claim 5, drawn to pyrrolidinyl compounds (n=1), classified in class 548, subclass various depending on species election, with traverse. In accordance with the Examiner's request for election of a particular species for search purposes, Applicants provisionally elect, with traverse, the compound of formula I having the

formula:



and is shown on page 30 as compound 59.

#### TRAVERSAL

Applicants respectfully traverse the Examiner's restriction requirement for the following reasons.

#### Searching All the Claims Is Not a Serious Burden

MPEP § 803 states that:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

There is no serious burden here. Irrespective of whether restriction may be required, the examiner must search at least all classes and subclasses directed to the compounds and those directed to the methods of making the compounds. The compound

classes and subclasses might well contain a patent having a disclosure relevant to the patentability of the method claims. At the Examiner's disposal are powerful electronic search engines providing the Examiner with the ability to quickly and easily search all of the claims. Searching two related classes is not even a small burden and certainly is no "serious burden" as required by the MPEP in order for the restriction requirement to be proper. Having paid an application fee, the applicant is entitled to have the examiner search all relevant subclasses.

Moreover, these classes and subclasses are assigned to the Examiner's art unit. Given their overlapping subject matter and identical classifications, examinations of all the invention groups would not pose a serious burden because they would be coextensive. Further, the fact that various claims may fall under different U.S. Patent and Trademark Office classes does not necessarily make them independent or distinct inventions. The classification system at the U.S. Patent and Trademark Office is based in part upon administrative concerns and is not necessarily indicative of separate inventive subject matter in all cases.

In addition, Applicant has paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims for which payment was made when this application was filed, Applicant must pay duplicative fees to file divisional applications for non-elected or withdrawn groups of claims.

**CONCLUSION**

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the restriction/election requirement and to examine all of the claims pending in this application.

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,  
**NATH & ASSOCIATES**

Date: Oct 21, 1999

**NATH & ASSOCIATES**

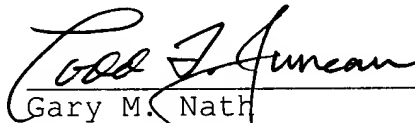
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